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25943 7590 01/29/2008 SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			EXAMINER VU, TUAN A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/741,219

**Applicant(s)**

BOSWORTH ET AL.

**Examiner**

Tuan A. Vu

**Art Unit**

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to the Applicant's response filed 11/01/07.

As decided in the conference regarding Applicant's request for Pre-Appeal Conference, prosecution of the Application is herein re-opened. Claims 1-24 are pending in the office action.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101. [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

Specifically, claim 21 recites apparatus comprising means for 'receiving ...', for 'analyzing and determining ...', and for 'effectuating ...'; all of which being recited in method

claim 1, and analyzed in light of the Specifications as software entities. The claim as a whole cannot be construed as a statutory category, because there is clear absence of hardware to support realization of the software functionality. According to the 101 Guidelines, mere listing of 'Functional Descriptive Material' (Annex IV) without proper computer medium for storage and execution of program instructions will be treated as non-statutory. Claim 24 amounts to storing order onto a file format, hence is still devoid of hardware support.

Along with claims 22-24, claim 21 is rejected for leading to non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 22-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the above claims, the recited limitation in terms of 'saving ... the execution order' is not only hard to construe but also insufficiently supported by the Disclosure. The unnested cells as recited in claims 1, 11, 21 appear to be crux in Applicant's endeavor, and this is substantially pointed out via Applicants' proffering as to how these cells have corroborating support in the Specifications; that is, the XSLT example of **page 7** (Appl. Rmrks pg. 7, bottom para). What is conveyed by 'saving ... the execution order' is expected to be a special step requiring a storing utility or construct, but such 'saving' or storage structure is not found anywhere near (emphasis

added) where these XSLT examples are mentioned; that is, the description related to these mutually 'unnested' cells is seen as devoid of an expected storage structure to contain a software or programmatic definition/entity **pertinent to** said 'execution order'. The Applicant is deemed not in possession of the above feature, or insufficient in providing a compliant description for a claimed feature; and this 'saving' of 'execution order' regarding the unnested cells of claims 1, 11, 21 will be given little patentable weight.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-6, 8-16, 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Renner et al., USPN: 6,993,657(hereinafter Renner)

**As per claim 1**, Renner discloses a method of computing, comprising:

receiving at execution time (e.g. *XSL sheets, statements* - col. 39, line 62 to col. 42, line 34), a data processing specification having a first and a second data processing cell specification, unnested (with respect to each other), specifying a first and a second data processing cell respectively, with each data processing cell specification having a plurality of statements including a formula specifying an action or computation (e.g. Table 4, *<FORM Name> ... xsl:apply-templates select = "custom" ... </FORM>*, lines 16-21; *<xsl:template match =*

"*custom*" ... *xsl:apply-template select = "input[...]"* ... *</xsl:template>* - lines 24-31 ) the first data processing cell having a data dependency on the second data processing cell (e.g. second cell group: lines 33-35, 36-38, 39-41, 42-44, 45-47 – Note: *fieldname*, *fieldlbl*, and *fieldval* depend on *@name*, *@label* and *@value*, respectively define *input* type in second cell, the processing of which is required to resolve action/computation defined as *<xsl: apply-template select = "input@ type ... input@type ..."/>* of line 26, which belongs to *</xsl: template match>* -- lines 24-31 – or cell group *<FORM NAME ... apply-templates select = "custom">* lines 16-21 , being first cell group, all of which unnested from second cell group ), and specified in a manner to be analyzed before the second data processing cell (Note: line 26 processed before line input of name type being resolved – value-of select - in lines 34, 37, 40,43, 46);

analyzing in real time, the first and then the second data processing cell specification to determine execution order of said actions/computations specified by said first data processing cell specifications, based at least in part on interaction or computation references between said actions or computations specified (e.g. Table 4, lines 26-31) and determine order of execution based on tag sequencing of specifications (refer to lines 24-31, for action definition - Note: using statements and formula/action inside xsl statement tags - *xsl:apply-template select* - to effectuate tag language reads on determining execution order therein); and

effectuating the data processing specified by the data processing specification in accordance with the determined execution order of said actions/computations specified by said first and second data processing cell specifications ( e.g. action in lines 24-31, being specified first, as a *match* method with *select* action, with variable processing with value substitution –

*value-of select* to resolve a input type match -- thereto reads on effectuating specification according to order of execution).

**As per claim 2**, Renner discloses each of said first and second data-processing cell specifications being delineated by a beginning and an ending data processing cell specification tag (e.g. `<xsl: ... />` - Table 4, lines 16-47).

**As per claim 3**, Renner discloses wherein said first data processing cell specification has a formula (e.g. `input[@type...]` line 26, Table 4) referencing a value (e.g. *fieldval*, *@value*, *VALUE="{ \$fieldval }"* -- line 39, 40, 54, respectively) of said second data processing cell specification.

**As per claims 4-5**, Renner discloses wherein one or both of said first and second data processing cell specifications comprise one or more attributes specifications specifying one or more attributes of the corresponding data processing cells(e.g. Table 4: *xsl: variable name=*, *xsl:value-of*, *TYPE= ...SIZE ... FONT ...BUTTON* col. 39; *name attribute* - col. 42, lines 3-18 ); wherein the first data processing cell has a first attribute (e.g. `input[@type` , line 26) referencing a second attribute (`input variable name= fieldname; fieldlbl; fieldval, fieldtype, fieldwidth` – line 33, 36, 39, 42, 45) said second data processing cell.

**As per claim 6**, Renner discloses wherein said second data processing cell specification comprises a reserved mnemonic for providing input (e.g. TABLE 4: *@name* line 34, *@label* line 37, *@value* line 40, *@type* line 43, *@size* line 46) to the data processing specified by the data processing specification.

**As per claim 8**, Renner discloses wherein said second data processing cell specification comprises a conditionally (e.g. col. 39, Table 4, lines 61, 66) executed formula.

As per claims 9-10, Renner discloses wherein said data processing specification further includes one or more global attributes (*<td width= ...align=right>* col. 39; line 80, line 54, line 64 -Table 4, col. 39) specifying one or more global processing characteristics for the specified data processing;

wherein said one or more global attributes include a global attribute specifying a format (*<FORM... </FORM>*, line 16-21; *name @type="text"*, line 26; *<...SIZE="15/>*, line 54; *<FONT ... </FONT>* lines 74-75, TABLE 4, col. 38-39 )for providing the specified data processing with an HTTP request.

As per claim 11, Renner discloses an apparatus comprising:

at least one storage unit having stored thereon programming instructions designed to:  
receive at execution time, a data processing specification having a a first and a second data processing cell specification, unnested -- with respect to each other (e.g. Table 4: lines 16-21; lines 24-31, lines 32-35; lines 36-38; lines 39-41), specifying a first and a second data processing cell (refer to claim 1), with each data processing cell specification having a plurality of statements including a formula specifying an action or computation (e.g. Table 4, col. 38: *<...METHOD="POST" ACTION= ...< xsl: apply-templates select=...>* lines 16-18),

the first data processing cell having a data dependency on the second data processing cell, and specified in a manner to be analyzed before the second data processing cell (e.g. second cell group: lines 33-35, 36-38, 39-41, 42-44, 45-47 – Note: *fieldname*, *fieldlbl*, and *fieldval* depend on *@name*, *@label* and *@value*, respectively define *input* type in second cell, the processing of which is required to resolve action/computation defined as *<xsl: apply-template select = "input@ type ... input@type ...]/>* of line 26, which belongs to *</xsl: template match>* -- lines



24-31 – or cell group <FORM NAME ... *apply-templates select = "custom"*> lines 16-21 ,  
being first cell group, all of which unnested from second cell group),

analyze in real time (e.g. Table 4, col. 38-39: first cell: line 33, 36, 39; second cell: lines 34, 37, 40 – Note: *fieldname*, *fieldlbl*, and *fieldval* depend on *@name*, *@label* and *@value*, respectively), the data processing specification to determine an execution order of said actions/computations specified by said first and second data processing cell specifications, based at least in part on interaction or computation references between said actions or computations specified (e.g. Table 4: col. 38 to col. 39 - 1<sup>st</sup> cell group: lines 16-21; lines 24-31; second cell group: lines 33-35, 36-38, 39-41, 42-44, 45-47 – Note: resolving actions field inside first cell group to determine how to obtain value from second cell group reads on real-time data processing based on said order of execution dictated by field in first cell group) and determine order of execution based on tag sequencing of specifications (Note: using statements and formula/action inside xsl statement tags to effectuate HTML reads on determining execution order therein); and

effectuate the data processing specified by the data processing specification in accordance with the determined execution order of said actions/computations specified by said first and second data processing cell specifications (e.g. col. 41, lines 42 to col. 42, line 19; col. 43, lines 19-50- Note: POST method in first cell group, with action specific -- e.g. as *apply-templates select = "input"*; *apply-templates select = "custom"* -- along with variable processing with value substitution thereto – Table 4, lines 33-47 -- in second cell group reads on effectuating specification according to order of execution); and at least

one processor coupled to said at least one storage unit to execute said programming instructions (e.g. Fig. 1).

**As per claims 12-16, and 18-20** these claims correspond to claims 2-6, and 8-10, respectively; hence are rejected with the corresponding rejection as set forth therein.

**As per claim 21**, this is a 'means-plus-functions' version claim corresponding claim 1, and comprises means for:

receiving at execution time (a data processing specification having a a first and a second data processing cell specification, unnested --with respect to each other...);

analyzing in real time (the data processing specification to determine an execution order...);

and

effectuating (the data processing specified by the data processing specification in

accordance...); all of these steps having been addressed in claim 1.

Hence, these limitations are herein rejected with the corresponding rejections as set forth therein.

**As per claim 22**, Renner discloses saving, after said determining, the execution order (e.g. Table 4 – col. 38-39; Fig. 6D – Note: GUI screen presenting order by which XML objects are sequenced as a result of a parsing and using XSLT construct implementation in order for these parsed objects to be visible for a HTML developer session **reads on** storing the order of XML parsing for display).

**As per claims 23-24**, refer to rejection of claims 22.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renner et al., USPN: 6,993,657, as applied to claims 1, 11; in view of W3C, 'XML Path Language (XPath)' and 'XSL Transformation (XSLT) Version 1.0; *W3C Recommendation 16 November 1999*, respectively < <http://www.w3.org/TR/1999/REC-xpath-19991116> > and < <http://www.w3.org/TR/xslt> > (hereinafter W3C – submitted in previous Office Action).

As per claim 7, Renner discloses XSL cells having dedicated input specifications (re claim 6) as these are defined via means of XML and the user's template; and further teaches providing or presenting in response to user's input required components, components for the build or a forum evaluation; or/and push back to the user's interface (e.g. Fig. 5A, 5D; step 689 – Fig. 6c; step 740 -Fig. 7; Fig. 8-9; *configuration information, necessary software* - Fig. 12B) but does not explicitly teach that said style sheet first data processing cell specifications has a reserved output cell/template specification specifying output for the data processing specification. The use of XSLT specification language to provide a reserve cell in a template for output is disclosed by W3C (e.g. *xsl: output, xsl: output method* – pg. 9-10; chp. 16.1, 16.2 pg. 79-80). Since the methodology of using XSL methodology by Renner incorporates the features by W3C and Renner's approach is using XML/XSL format via users request (Table 4) converting input into database request returns into the building interface, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide

Renner's use of W3C and style sheets specification so that dedicated XSL field or tags are reserved to define output specifications as taught by W3C. One of ordinary skill would be motivated to do this because of the interactive nature of Renner's build having the user to assess data being returned from a request; and using XSL output cell dedicated specifications as by W3C would support the correctness of data conveyed in HTML form as they are returned into Renner's building/forum or customer service communication scenario (see Fig. 6C-D, Fig. 9, Fig. 10; col. 12, line 7 to col. 13, line 7) in that the user can assess the correct format via this output cell specification according to mime format and text/character type as mentioned by W3C in such that every build interface and submitted data field is appropriately addressed ( see Renner Fig. 5C-D).

As per claim 17, this claim corresponds to claim 7; hence is rejected using the same rationale as set forth therein.

#### ***Response to Arguments***

10. Applicant's arguments filed 11/01/07 have been fully considered but they are not persuasive. Following are the Examiner's observation in regard thereto.

(A) The Office Action has withdrawn the previous USC 112 Rejection, but will address the 'unnested' limitation based upon Applicant's clarification via explicit acknowledging that the XSLT Example such as at page 7 (Appl. Rmrks pg. 7, bottom para) of the Disclosure --about these unnested cells -- is actually what is claimed, and thus supports the claims.

(B) Regarding Claim 1 and Applicant's argument that Renner's cited XSLT lines are located within the scope of one another (Appl. Rmrks, pg. 4, bottom), i.e. *unnested with respect to each other* as required. The rejection has focused on this cell specification limitation in terms of a

first cell group being unnested from a second cell group so that action tag specification within the scope of the first has to be processed by resolving cell definition tag in the second cell group. The Office action has taken into consideration Applicant's argument (see Appl. Rmrks, pg. 7-8) regarding the previously effectuated 35 USC 112, 1<sup>st</sup> paragraph rejection (i.e. against the insufficient support for the 'unnested' relationship in the claim), and based on Applicant's admission that examples in the Specifications -- notably the XSLT cells -- is crucial part of the claimed invention, the engrossed effect of these examples is now addressed. In light of Applicant's weight particularly given to this 'unnested' aspect of XSLT cells as illustrated on pages 6, 7 of the Disclosure, the Office Action has mapped similar cell disposition and order of execution in Renner's XSLT Table 4 with explicit showing how these first and second cell group entail an order of processing, and that they do not belong to one another scope. The Renner reference is deemed fulfilling what appears to be Applicant's main feature.

(C) Applicants have submitted that Renner order of analysis and execution is same, hence Renner does not disclose saving after determining. The claim does not provide sufficient details regarding how a action being determined when processing a first cell is stored, and then using said storage structure to address the processing order subsequent to said first cell determination. The programmatic flow of parsing and resolving tag in Renner entails a necessary scenario (\*) by which a action is detected (in the first cell) for its requiring of a missing value, the program has to stop at that address location, and saving the context before it is moving onto another part of the code to resolve the missing value; and after obtaining the value from the second cell, the value is being transfer back to the above context, at which point the value is incorporated inside the tag action of the first cell. Clearly a saving of context when addressing the order is taught as

integral part of Renner's XSLT processing. Regarding the unnested cells of Applicant's disclosure illustrated at page 7, it is highly questionable as to how the saving of order is described in this section. Since claim 1, 11, 21 are about this unnested aspect as described at those examples, it is deemed that the saving as recited in claims 22-24 is insufficiently supported (refer to the USC § 112 Rejection) and will be given little patentable weight beyond what is analyzed from above (see \*).

In light of the above, the claims will be rejected as set forth in the Office Action.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (571) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571)272-3756.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 ( for non-official correspondence - please consult Examiner before using) or 571-273-8300 ( for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Tuan A Vu', with a long horizontal stroke extending to the right.

Tuan A Vu  
Patent Examiner,  
Art Unit 2193  
January 28, 2008